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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 08/934,968
Filing Date: 09/22/97
Appellant(s): Bell

Paper No. 8

MAILED

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Group 2700

Maria McCormack Sobrino
For Appellant

EXAMINER'S ANSWER

1. This is in response to appellant's brief on appeal filed on August 2, 1999, paper No. 7. Remaining at issue are the rejection under *35 USC § 103* of claims 1-10.
2. The statement of the status of claims contained in the brief is correct.
3. The appeal involves claims 1-10, in the case.
4. No claims have been allowed.
5. No claims have been objected.
6. The appellant's statement of the status of amendment after final rejection contained in the brief is correct.

The text of those action of Title 35 U.S.C. Code relied upon in this appeal can be found in the prior Office Actions.

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Ward (US No. 5,448,708)	September 5, 1995
Glassen et al. (US No. 5,671,441)	September 23, 1997

7. The summary of invention contained in the brief on page 3 is correct.
8. The copy of the appealed claims 1-10 contained in the Appendix to the brief is correct.
9. The appellant's brief includes a statement that the rejection of claims 1-10 stand or fall together and provides reasons as set forth in 37C.F.R.1.192(c)(5) and (c)(6).
10. The appellant's statement of the issues in the brief on page 4 correct.
11. No new prior art has been applied in this examiner's answer.

Grounds of Claim Rejections - 35 USC § 103 (claims 1-10)

12. Claims 1-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ward (US No. 5,448,708) in view of Glassen et al. (US No. 5,671,441).

In regards to claims 1, 5, and 9, Ward discloses the method and apparatus for dynamically sending device data in the bus transaction comprising first device 88 issue request comprising a device control/data field; the second device 100 generating and issue a reply comprising a plurality of field and wherein the second device copying data received from the first device into the designate field of the plurality of field of the reply (see col. 11, lines 7-51). But Ward does not disclose the field including the device configuration field. However Glassen et al. disclose

the field including the device configuration field (see col. 5, line 65 through col. 6, line 31). Therefore, it would have been obvious to a person of an ordinary skill in the art at the time the invention was made to have combined the teachings of Glassen et al. into the teachings of Ward because it would provide the dynamical configuration for device in the computer system.

In regards to claims 2 and 6, Ward discloses the designated field is located at a location in the reply that corresponds to a field location of the device configuration of the request (see col. 11, line 52 through col. 12, line 20).

In regards to claims 3, 7, and 10, Ward discloses the device configurable field is used by the first device to store an transaction identification of the transaction issued by the first device (see col. 11, lines 38-52).

In regards to claims 4 and 8, Ward further discloses the first device reading the designated field to determine the identification to the request the reply corresponding to (see col. 12, lines 22-40).

Rebuttal

13. The Examiner has carefully considered the arguments set forth by appellant in the brief and finds the argument to be unpersuasive.

14. In the brief, appellant argued in substance as to the rejection of claims 1-10:
(1) The Ward reference does not teach or disclose a first device sending a request to a second device, a request comprising a plurality of fields including a device configurable field containing device configuration data, and a second device copying a device configurable data from the device configurable field of the request into a designated field of the reply and issuing a reply.

(2) The combination of the Ward and Glassen references does not teach or disclose a first device sending a request to a second device, a request comprising a plurality of fields including a device configurable field containing device configuration data, and a second device copying a device configurable data from the device configurable field of the request into a designated field of the reply and issuing a reply.

As (1), Ward disclose the client entity 202 (i.e first device) sending a request to the server entity 208 (i.e. second device) by placing the request control element 204 (see figure 1, col. 3, lines 48-62) wherein the request control element 204 contains a format identifier, a length field, common indicators field, source and destination fields, a correlation field and an entity-to-entity field that varies length (see col. 5, lines 40-45); the server 208 (i.e. second device) generates the control element 216 (i.e. reply) which contains (i.e. copies) the data into the control element 216 along with the fields (see figure 1, col. 4, lines 11-30).

As (2), Examiner contends that applicant's arguments against the reference individually (i.e. device configurable field) that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Examiner acknowledged that Ward does not disclose the device configurable field along with the request however Examiner found Glassen reference to remedy the deficiencies of Ward reference. Glassen reference discloses the programmable subchannel which detect and establish the device I/O configurable fields for each device

connected to the plurality of channels (see col. 5, line 65 through col. 6, line 47). By having the remedy of Glassen reference, it would provide a dynamically changing configuration for devices within a sharing system. The examiner recognizes the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case the combination of Glassen reference into Ward. Examiner found the device configurable fields in Glassen reference to remedy the deficiencies in Ward reference. Furthermore, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case the combination of Glassen into Ward provide a dynamically changing configuration of devices within a sharing system.

15. For the reasons started hereinabove, the Examiner believes that the rejections should be sustained.

RP

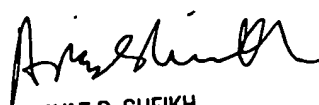
Raymond Phan
November 4, 1999

Respectfully submitted,

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